

Hearing:

October 5, 1999

Paper No. 26

EWB/MM

THIS DISPOSITION IS NOT

CITABLE AS PRECEDENT OF THE TTAB 5/19/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mannatech, Inc.
v.
IntraCell Nutrition, Inc.

Opposition No. 108,379
to application Serial No. 75/028,423
filed on December 6, 1995

Randall C. Brown of Akin, Gump, Strauss, Hauer & Feld, LLP
for Mannatech, Inc.

Deborah L. Benson of Hinckley, Allen & Snyder for IntraCell
Nutrition, Inc.

Before Cissel, Hanak and Hairston, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

IntraCell Nutrition, Inc. (applicant) seeks to register
MANNA in typed drawing form for "dietary food supplements
for human consumption." The application was filed on
December 6, 1995 with a claimed first use date of June 1984.

Mannatech, Inc. (opposer) filed a notice of opposition
alleging that pursuant to Section 2(e)(1) of the Trademark

Act, the term MANNA is not registerable as a trademark because it is merely descriptive of dietary food supplements for human consumption. Continuing, opposer alleged that it manufactures and sells nutritional supplements, and that the grant of a registration to applicant for the term MANNA would tend to impair opposer's right to use this descriptive term.

Applicant filed an answer which denied that MANNA is merely descriptive of dietary food supplements for human consumption.

Both parties filed briefs and were present at a hearing held on October 5, 1999.

The voluminous record in this case is summarized at pages 1-6 of opposer's brief. At page 1 of its brief, applicant states that it "concurs with opposer's recitation of the record," with two minor exceptions which are of no consequence to the outcome of this decision.

At the outset, two procedural matters need to be addressed. First, opposer's motion for leave to file a supplemental notice of reliance is granted as uncontested. Second, opposer's motion to strike the testimony of applicant's expert (Samuel Birger) is also granted. As applicant acknowledges, on April 18, 1998 applicant answered opposer's Interrogatory No. 24 by stating, in part, that applicant "has not identified an expert witness to testify,

but reserves its right to do so." Subsequently, applicant changed its position and elected to call Mr. Birger as an expert witness. On July 30, 1998 counsel for applicant served on counsel for opposer via fax and first class mail notice that applicant would take the deposition of Mr. Birger on August 7, 1998. On July 31, 1998 counsel for applicant notified counsel for opposer that the Birger deposition would be rescheduled for August 10, 1998. However, it was not until some unspecified time after July 31 that counsel for applicant informed counsel for opposer "that Mr. Birger was a linguistics expert who would offer his opinion about whether the term MANNA is descriptive of a vitamin or dietary supplement." (Grimm affidavit paragraph 10). Moreover, counsel for applicant acknowledges that Mr. Birger's expert report (as well as the other exhibits to be introduced at Mr. Birger's deposition) were not sent to counsel for opposer until Friday, August 7, 1998. (Grimm affidavit paragraph 11). Mr. Birger's expert report was not received by counsel for opposer until Saturday, August 8, 1998, just two days prior to his August 10, 1998 deposition. In view of the foregoing, we concur with opposer that it did not have adequate time to prepare for Mr. Birger's deposition. Accordingly, we have not considered Mr. Birger's deposition testimony, nor have we considered Mr. Birger's expert report (Exhibit D).

However, two points should be made. First, we have taken into consideration Exhibits A-C to Mr. Birger's deposition because these are simply photocopies of pages from three different dictionaries wherein the term "manna" appears. This Board can and routinely does take judicial notice of dictionaries, and it is of no consequence how the dictionary listings are brought to the attention of the Board. Indeed, this Board routinely considers photocopies of dictionary listings that are attached to final briefs. In addition, we note that opposer has also made reference to Birger Exhibit A (The Oxford English Dictionary, 2d ed. 1989) in support of opposer's position. (See opposer's brief page 13).

Second, our decision not to consider Mr. Birger's testimony or his expert report is of little consequence because his testimony essentially describes the various definitions of the word "manna" which appear in the three dictionaries (Exhibits A-C). This Board is fully capable of reviewing these three dictionaries without the assistance of Mr. Birger. Moreover, Mr. Birger's expert report essentially summarizes the various dictionary definitions of the word "manna," and then comes to the not unsurprising conclusion that MANNA "is not descriptive of the vitamins/dietary supplements being sold by [applicant] under

that name, or of any vitamin/mineral or dietary supplement product and/or food generally."

We now turn to a consideration of whether opposer has established that MANNA is merely descriptive of "dietary food supplements for human consumption," applicant's chosen description of its goods.

As has been stated repeatedly, "a term is merely descriptive if forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

In its initial brief, it was opposer's position that various dictionaries, printed publications and Internet "stories" demonstrate that one meaning of the word "manna" is that of a particular type of laxative, and that because a laxative "is a likely ingredient of a dietary supplement," applicant's mark MANNA is merely descriptive of dietary food supplements for human consumption. (Opposer's brief page 11). In the "Conclusion" section of its initial brief,

opposer makes the following statement: "A laxative is clearly a dietary supplement and 'manna' is a potential ingredient of a dietary supplement." (Opposer's brief page 15). However, at pages 1 and 2 of its reply brief, opposer for the first time argues that the evidence of record demonstrates that the word "manna" refers not only to a laxative, but also to a demulcent (a substance capable of soothing an abraded mucous membrane) and to a sweet supplement used to disguise the taste of medicines. Put quite simply, in its reply brief, opposer now takes the position that manna "is used as a sweetener, a demulcent and a laxative." (Opposer's reply brief page 2). For support that manna is both a laxative and a demulcent, opposer refers to Webster's New Collegiate Dictionary (1981) which lists the following as a secondary definition for the word "manna": "2: sweetish dry exudate esp. of a European ash that contains mannitol and has been used as a laxative and a demulcent." (Opposer's exhibit 52). For support that manna is a sweetener, opposer refers to a 1995 "story" appearing on the Internet supposedly authored by Mrs. M. Grieve. (Opposer's exhibit 27). This Internet "story" contains the following sentence: "It [manna] was formerly used in medicine as a gentle laxative, but is now chiefly used as a children's laxative or to disguise other medicines." (emphasis added). With regard to this Internet "story," it

should be noted that this story is not competent evidence to prove the truth of the statements contained therein. This story simply demonstrates that someone identifying herself as Mrs. M. Grieve made the foregoing statements, and that an unspecified number of individuals saw these statements.

However, even if we assume for the sake of argument that some of the many meanings of the term "manna" include a laxative, a demulcent and a sweetener to disguise the taste of other medicines, opposer has failed to prove that the mark MANNA is merely descriptive of an ingredient or potential ingredient of dietary food supplements for human consumption because opposer has offered no evidence whatsoever that dietary food supplements for human consumption contain or may contain laxatives, demulcents or sweeteners to disguise the taste of other medicines. Indeed, the only evidence that opposer offered with regard to whether dietary food supplements for human consumption contain any of the aforementioned three ingredients is the testimony of applicant's CEO, Elliott Goodman. When questioned on direct examination by counsel for opposer, applicant's CEO testified that he would not consider laxatives to be dietary supplements. (Goodman deposition page 11). Mr. Goodman was not asked as to whether demulcents or sweeteners to mask the taste of medicines were

ingredients or potential ingredients of dietary food supplements for human consumption.

In short, opposer has failed to establish that MANNA is merely descriptive of dietary food supplements for human consumption because opposer has simply failed to show that laxatives, demulcents or sweeteners to mask the taste of medicines are ingredients or even potential ingredients for said dietary food supplements. To be perfectly clear, we are not suggesting that it was incumbent upon opposer to prove that applicant's particular dietary food supplements for human consumption contained laxatives, demulcents or sweeteners to mask the taste of medicines. In determining whether a word is merely descriptive, the test is not whether the word is merely descriptive of the ingredients or characteristics of applicant's actual goods, rather the test is whether the word is merely descriptive of the ingredients or characteristics of the goods as described in the application. See In re Allen Electric & Equipment Co., 173 USPQ 689, 690 (CCPA 1972)(The proposed mark SCANNER was held to be merely descriptive of the goods as described in the application -- antennas -- because the evidence demonstrated that there were certain types of antennas known as "scanning antennas." The fact that applicant's actual antennas were not scanning antennas did not preclude a finding that the

proposed mark SCANNER was merely descriptive of the goods set forth in the application, namely, antennas).¹

Even if we assume for the sake of argument that opposer established that laxatives, demulcents or sweeteners to mask the taste of medicines were ingredients or potential ingredients of dietary food supplements for human consumption, there is an additional reason why opposer has failed to prove that applicant's mark MANNA is merely descriptive of said dietary food supplements. Opposer has

¹ In addition to arguing that the word "manna" is descriptive of dietary food supplements for human consumption because this word means laxative, demulcent or a sweetener to mask the taste of medicines, opposer very briefly argues that manna is also descriptive of dietary food supplements because it is defined as "a valuable staple food" and as "a juice obtained from incisions in the bark of various trees." According to opposer, "a juice is a food." (Opposer's brief page 13). It is interesting to note that opposer supports these two definitions of the word "manna" by making reference to Mr. Birger's testimony and to Exhibit A to Mr. Birger's testimony, namely, The Oxford English Dictionary 2d ed. 1989). However, this dictionary makes it clear that the definition of "manna" as "a valuable staple of food" is obsolete. An obsolete word or an obsolete definition of an existing word do not establish that said word is merely descriptive. See 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:33 at page 11-57 (4th ed. 1999) and cases cited therein. As for opposer's contention that "manna" is defined as "a juice obtained from incisions in the bark of various trees," what opposer fails to note is that The Oxford English Dictionary (2d ed. 1989) goes on to note that this juice "is used in a medicine as a gentle laxative." Thus, opposer is simply wrong by implying that The Oxford English Dictionary (2d ed. 1989) defines "manna" as a juice which can be used as food. Said dictionary defines "manna" as, in one sense, a juice which is used in medicine as a gentle laxative.

offered no evidence whatsoever showing that purchasers or potential purchasers of dietary food supplements for human consumption would understand that the word "manna" means laxatives, demulcents or sweeteners to mask the taste of medicine. This Board has reviewed literally dozens of dictionaries, and the majority of them do not define the word "manna" as a laxative or as a demulcent. None of them define "manna" as a sweetener to mask the taste of medicine. Only the Grieve Internet "story" does this. A review of these dictionaries shows that the primary meanings of the word "manna" refer to the food miraculously provided to the Israelites in the wilderness, or to any miraculously provided food or assistance. Opposer does not dispute that the foregoing are the primary meanings of the word "manna." Moreover, opposer does not contend that the foregoing primary meanings are descriptive of dietary food supplements for human consumption. Obviously, purchasers or potential purchasers of said dietary food supplements would hardly believe that they were miraculously provided from above.

Besides taking the deposition of applicant's CEO, opposer's only other witnesses were employees of opposer's counsel, namely, Ingrid Ricketson (a paralegal) and Rick Matos (a patent agent). Neither witness testified that purchasers or potential purchasers of dietary food supplements for human consumption would understand the word

"manna" to mean a laxative, a demulcent or a sweetener to mask the taste of medicines. Opposer never took the deposition of any purchaser, potential purchaser, distributor or manufacturer of said dietary food supplements in an effort to prove that a purchaser or potential purchaser would understand the word "manna" to have any of the foregoing three meanings.

In short, opposer has simply failed to establish that the alternate meanings of the word "manna" found in some dictionaries as meaning laxative or demulcent would be known to purchasers or potential purchasers of dietary food supplements. In addition, opposer has failed to establish the Grieve Internet "story" describing manna as a substance to disguise the taste of other medicines would likewise be known to purchasers or potential purchasers of dietary food supplements.

Decision: The opposition is dismissed.

R. F. Cissel

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal